

REMARKS

The Office Action dated June 23, 2009, has been received and carefully considered. In this response, claim 66 has been amended and claim 67 has been added. No new matter has been added. Entry of the amendments to claim 66 and the addition of claim 67 is respectfully requested. Reconsideration of the rejections pending in the present application is also respectfully requested based upon the amendments and arguments presented herein, the amendments and arguments previously submitted, and the discussions held between Examiner Nguyen, the Applicant, and the undersigned attorney of record on July 22, 2009.¹

I. THE EXAMINER INTERVIEW

At the outset, the undersigned thanks Examiner Nguyen for the courtesies extended during the interview conducted on July 22, 2009, during which agreement was reached on the Applicant presenting new claim 67 for consideration by the Examiner, which is reflected herein. As discussed during the interview,

¹ As Applicant's remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicant's silence as to assertions made by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., assertions regarding dependent claims, whether a reference constitutes prior art, whether references are legally combinable for obviousness purposes) is not a concession by Applicant that such assertions are accurate or such requirements have been met, and Applicant reserves the right to analyze and dispute such in the future.

Applicant proposed, and the Examiner agreed to consider, replacing claim 66 with new claim 67. Applicant also proposed cancelling claim 66 and the remaining pending claims (i.e., claims 48-65) if the Examiner agreed to replace claim 66 with new claim 67, and new claim 67 is found to be allowable.

II. THE ELECTION/RESTRICTION REQUIREMENT

On page 2 of the Office Action, the Examiner asserts that claim 66 is directed to an invention that is independent or distinct from the invention originally claimed. Specifically, the Examiner asserts that claim 66 is directed to a tracking process and mechanism that is absent from the original claimed invention.

Applicant hereby respectfully traverses this election/restriction requirement, and hereby requests that the Examiner reconsider and withdraw this election/restriction requirement.

As discussed above, during the interview, Applicant proposed, and the Examiner agreed to consider, replacing claim 66 with new claim 67. Thus, this election/restriction requirement could be made moot if the Examiner indeed agrees to replace claim 66 with new claim 67, and new claim 67 is found to be allowable.

However, as also discussed during the interview, original claims 4, 11, 17, and 19 (with support from paragraphs [0010] and [0069]) clearly recited tracking means and processes. Thus, Applicant respectfully submits that this election/restriction requirement is not proper. Applicant notes that new claim 67 also recites a tracking process that is also fully supported by the specification and original claims.

At this point, Applicant notes that claim 66 has been amended to remove bracketed reference designators and paragraph numbers.

In view of the foregoing, Applicant respectfully submits that this election/restriction requirement is improper, and the withdrawal of such election/restriction requirement is respectfully requested.

III. THE WRITTEN DESCRIPTION REJECTION OF CLAIMS 59, 60, 63, 64

On page 3 of the Office Action, claims 59, 60, 63, and 64 were rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This rejection is hereby respectfully traversed.

First of all, as discussed above, Applicant proposed cancelling claims 48-65 if the Examiner agreed to replace claim 66 with new claim 67, and new claim 67 is found to be allowable. Thus, if the Examiner agrees to replace claim 66 with new claim 67, and new claim 67 is found to be allowable, then this rejection becomes moot as claims 48-65 will be cancelled.

Secondly, Applicant respectfully submits that claims 59, 60, 63, and 64 are indeed fully supported by the specification. For example, regarding claims 59 and 63, the specification supports the concept of a third party providing consumer data. See, e.g., paragraphs [0011], [0068], [0089], and [0090]. Also, regarding claims 60 and 64, the specification supports the concept of redeeming coupons that do not identify a specific retailer. See, e.g., paragraphs [0073]-[0086], [0089], and [0090].

At this point, Applicant would like to respectfully note that, as stated in MPEP § 2163.02, the fundamental factual inquiry is whether a claim defines an invention that is clearly conveyed to those skilled in the art at the time the application was filed. The subject matter of the claim need not be described literally (i.e., using the same terms or in *haec verba*) in order for the disclosure to satisfy the description requirement. Also, as stated in MPEP § 2163.07(a), by disclosing in a patent application a device that inherently

performs a function or has a property, operates according to a theory, or has an advantage, a patent application necessarily discloses that function, theory or advantage, even though it says nothing explicit concerning it. The patent application may later be amended to recite the function, theory, or advantage without introducing prohibited new matter. In re Reynolds, 443 F.2d 384 (CCPA 1971), In re Smythe, 480 F. 2d 1376 (CCPA 1973).

In view of the foregoing, Applicant respectfully requests that the aforementioned written description rejection of claims 59, 60, 63, and 64 be withdrawn.

IV. THE OBVIOUSNESS REJECTION OF CLAIMS 48, 49, 52, 53, 56-65

On pages 3-10 of the Office Action, claims 48, 49, 52, 53, and 56-65 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. US2004/0220854A1 to Postrel ("Postrel") in view of U.S. Patent No. 6,321,208 to Barnett et al. ("Barnett"), the GMA Press Release (GMA, Joint Industry Coupon Committee Unveil Comprehensive New Report on Couponing; Study Offers Key Learnings, Voluntary Guidelines to Make Process More Efficient, Effective), the Ewoldt article (Clip & save these tips), and U.S. Patent No. 6,055,513 to Katz et al. ("Katz"). This rejection is hereby respectfully traversed.

Under 35 U.S.C. § 103, the Patent Office bears the burden of establishing a prima facie case of obviousness. In re Fine, 837 F.2d 1071, 1074 (Fed. Cir. 1988). There are four separate factual inquiries to consider in making an obviousness determination: (1) the scope and content of the prior art; (2) the level of ordinary skill in the field of the invention; (3) the differences between the claimed invention and the prior art; and (4) the existence of any objective evidence, or "secondary considerations," of non-obviousness. Graham v. John Deere Co., 383 U.S. 1, 17-18 (1966); see also KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727 (2007). An "expansive and flexible approach" should be applied when determining obviousness based on a combination of prior art references. KSR, 127 S. Ct. at 1739. However, a claimed invention combining multiple known elements is not rendered obvious simply because each element was known independently in the prior art. Id. at 1741. Rather, there must still be some "reason that would have prompted" a person of ordinary skill in the art to combine the elements in the specific way that he or she did. Id.; In re Icon Health & Fitness, Inc., 496 F.3d 1374, 1380 (Fed. Cir. 2007). Also, modification of a prior art reference may be obvious only if there exists a reason that would have prompted a person of ordinary skill to make the change. KSR, 127 S. Ct. at 1740-41.

Regarding claim 48, the Examiner asserts that the claimed invention would have been obvious in view of Postrel, Barnett, the GMA Press Release, the Ewoldt article, and Katz. Applicant respectfully disagrees. Specifically, Applicant respectfully submits that Postrel, Barnett, the GMA Press Release, the Ewoldt article, and Katz, either alone or in combination, fail to disclose, or even suggest, a method wherein manufacturers and consumers both interface with a separate host computer system in a 3-party system resulting in the generation of a 3-party manufacturer coupon, which is generated by the host computer system as directed by a manufacturer and distributed to a physical address of a registered consumer using the host computer system as directed by the manufacturer, such that the 3-party manufacturer coupon may be redeemed at a separate retailer by the registered consumer, as claimed. In contrast, as detailed in Applicant's prior responses and inventor declaration, Postrel, Barnett, the GMA Press Release, the Ewoldt article, and Katz, either alone or in combination, simply disclose, at best, 2-party systems involving only retailers and consumers. Indeed, Postrel, Barnett, the GMA Press Release, the Ewoldt article, and Katz, either alone or in combination, fail to disclose, or even suggest, a separate host computer system that interfaces with both manufacturers and consumers in a 3-party coupon system, generates a 3-party manufacturer coupon at

the direction of manufacturer, and is used to distribute the 3-party manufacturer coupon to a physical address of a registered consumer as directed by the manufacturer, such that the 3-party manufacturer coupon may be redeemed at a separate retailer by the registered consumer, as presently claimed. Accordingly, is it respectfully submitted that claim 48 is allowable over Postrel, Barnett, the GMA Press Release, the Ewoldt article, and Katz, either alone or in combination.

At this point Applicants would like to respectfully remind the Examiner that, as stated in MPEP § 2143.03, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981 (CCPA 1974). That is, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382 (CCPA 1970). Also, as stated in MPEP § 2143.01, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 (Fed. Cir. 1984). Further, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In re

Ratti, 270 F.2d 810 (CCPA 1959). Thus, in addition to failing to disclose, or even suggest, all of the limitations of claim 48 as discussed above, any combination of Postrel, Barnett, the GMA Press Release, the Ewoldt article, and Katz to arrive at the claimed invention would also result in an improper modification of one or more of these references since none of these references actually disclose a 3-party coupon system.

Regarding claims 49, 56, and 58-61, these claims are dependent upon independent claim 48. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071 (Fed. Cir. 1988). Thus, since independent claim 48 should be allowable as discussed above, claims 49, 56, and 58-61 should also be allowable at least by virtue of their dependency on independent claim 48. Moreover, claims 49, 56, and 58-61 recite additional features which are not disclosed, or even suggested, by the cited references taken either alone or in combination. For example, claim 49 recites a separate host computer system that interfaces with manufacturers, consumers, and retailers in a 3-party coupon system, generates a 3-party retailer coupon at the direction of retailer, and is used to distribute the 3-party manufacturer coupon to a physical address of a registered consumer as directed by the retailer, such that the 3-party

retailer coupon may be redeemed at the retailer by the registered consumer, as presently claimed.

Regarding claims 52, 53, 57, and 62-65, while different in overall scope, these claims recite subject matter related to claims 48, 49, 56, and 58-61, respectively. Thus, the arguments set forth above with respect to claims 48, 49, 56, and 58-61 are equally applicable to claims 52, 53, 57, and 62-65. Accordingly, it is respectfully submitted that claims 52, 53, 57, and 62-65 should be allowable over Postrel, Barnett, the GMA Press Release, the Ewoldt article, and Katz, either alone or in combination, for the same reasons as set forth above with respect to claims 48, 49, 56, and 58-61.

In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejection of claims 48, 49, 52, 53, and 56-65 be withdrawn.

V. THE OBVIOUSNESS REJECTION OF CLAIMS 50, 51, 54, AND 55

On page 11 of the Office Action, claims 50, 51, 54, and 55 were rejected under 35 U.S.C. § 103(a) as being unpatentable over

U.S. Patent Application Publication No. US2004/0220854A1 to Postrel ("Postrel") in view of U.S. Patent No. 6,321,208 to Barnett et al. ("Barnett"), the GMA Press Release (GMA, Joint Industry Coupon Committee Unveil Comprehensive New Report on

Couponing; Study Offers Key Learnings, Voluntary Guidelines to Make Process More Efficient, Effective), the Ewoldt article (Clip & save these tips), and U.S. Patent No. 6,055,513 to Katz et al. ("Katz"), and further in view of U.S. Patent No. 6,820,062 to Gupta et al. ("Gupta"). This rejection is hereby respectfully traversed.

It is respectfully submitted that the aforementioned obviousness rejection of claims 50, 51, 54, and 55 has become moot in view of the deficiencies of the primary references (i.e., Postrel, Barnett, the GMA Press Release, the Ewoldt article, and Katz) as discussed above with respect to independent claims 48 and 52. That is, claims 50, 51, 54, and 55 are dependent upon independent claims 48 and 52 and thus inherently incorporate all of the limitations of independent claims 48 and 52. Also, the secondary reference (i.e., Gupta) fails to disclose, or even suggest, the deficiencies of the primary references as discussed above with respect to independent claims 48 and 52. Indeed, the Examiner does not even assert such. Thus, the combination of the secondary reference with the primary references also fails to disclose, or even suggest, the deficiencies of the primary references as discussed above with respect to independent claims 48 and 52. Accordingly, claims 50, 51, 54, and 55 should be allowable over the combination of the secondary reference with the primary

references at least by virtue of their dependency on independent claims 48 and 52. Moreover, claims 50, 51, 54, and 55 recite additional features which are not disclosed, or even suggested, by the cited references taken either alone or in combination.

In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejection of claims 50, 51, 54, and 55 be withdrawn.

VI. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

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Attorney Docket No.: 74331.000004

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